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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,388

09/19/2003

Marc M. Gibeley

86880THC

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06/13/2008

Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

JERABEK, KELLY L

ART UNIT

PAPER NUMBER

2622

MAIL DATE

DELIVERY MODE

06/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/666,388	Applicant(s) GIBELEY ET AL.	
	Examiner KELLY L. JERABEK	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,9,10,12-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,7,9,10 and 12-29 is/are allowed.
- 6) ☒ Claim(s) 31 and 33 is/are rejected.
- 7) ☒ Claim(s) 32 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, see amendment pages 9-10, filed 3/19/2008, with respect to claim 1 have been fully considered and are persuasive. The rejection of claim 1 has been withdrawn.

Claim Objections

Claims 31 and 33 are objected to because of the following informalities: The preambles of claims 31 and 33 read "Apparatus comprising:...". The claims should read "An apparatus comprising:...". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2622

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 46 of copending Application No. 10/895,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because the language contained in claims 31 and 33 of the current application that is different from the claim language of claim 46 of copending Application No. 10/895,565 is an obvious variation of claim 46 of copending Application No. 10/895,565. Therefore, a terminal disclaimer is required to insure that any patent issuing from copending Application No. 10/895,565 and any patent issuing from this application are commonly owned otherwise, a potential licensee would be required to negotiate with two different parties.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 1-4, 7, 9-10 and 12-29 are allowed.

The following is an examiner's statement of reasons for allowance:

Re claims 1-4, 7, 9-10 and 12-29, the prior art fails to teach or suggest, "A method of providing photofinishing services, comprising the steps of: a) supplying to a photographer at least one removable memory device selected from a variety of available formats and having a format appropriate for use in a digital camera provided by the photographer; b) the photographer selectively photographing and storing, and optionally deleting some or all of, a plurality of digital images on the at least one removable memory device; c) the photographer delivering the at least one removable memory device containing undeleted ones of the digital images to a photofinisher, including the steps of **the photofinisher reading a code stored on the at least one removable memory device and accessing a database to determine whether the database includes verification data corresponding to the code stored on the at least one removable memory device, said verification data indicating to the photofinisher that the photofinisher is committed to produce prints of the digital images stored on the at least one removable memory device**; d) the photofinisher producing prints of the digital images stored on the at least one removable memory device and returning the prints to the photographer; and e) the photofinisher erasing the digital images from the at least one removable memory device and preparing the at least one removable memory device to be supplied to another photographer to repeat steps b) through e).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Re claim 32, the prior art fails to teach or suggest, "An apparatus comprising: a digital camera including a removable memory card having image data stored thereon; the removable memory card comprising a first portion of memory that is electronically readable by a photofinishing services provider but not by the digital camera, and a second portion of memory that is electronically readable by the photofinishing services provider and by the digital camera; and the first portion of the memory comprising a code for use by the photofinishing services provider to verify that the photofinishing services provider is committed to create prints of the image data stored on the removable memory card, **wherein the photofinishing services provider**

electronically reads the code stored on the removable memory card and then checks if the code corresponds to a valid code saved in a database of codes at the photofinishing services provider."

Re claim 34, the prior art fails to teach or suggest, "An apparatus comprising: a memory card capable of being electronically coupled to a digital camera having image data stored thereon; the memory card comprising a first portion of memory that is electronically readable by a photofinishing services provider but not by the digital camera, and a second portion of memory that is electronically readable by the photofinishing services provider and by the digital camera; the second portion of memory having said image data stored thereon; and the first portion of the memory comprising a code for use by the photofinishing services provider to verify that the photofinishing services provider is committed to create prints of the image data stored on the second portion of memory, **wherein the photofinishing services provider electronically reads the code stored on the removable memory card and then checks if the code corresponds to a valid code saved in a database of codes at the photofinishing services provider."**

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly L. Jerabek whose telephone number is **(571) 272-7312**. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached at **(571) 272-7372**. The fax phone number for submitting all Official communications is **(571) 273-7300**. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at **(571) 273-7312**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kelly L. Jerabek

Examiner, Art Unit 2622

/Lin Ye/

Supervisory Patent Examiner, Art Unit 2622